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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,478	02/12/2004	Nicola Funnell	1578.607 (11758-US-PAT)	2295

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RESEARCH IN MOTION
ATTN: GLENDA WOLFE
BUILDING 6, BRAZOS EAST, SUITE 100
5000 RIVERSIDE DRIVE
IRVING, TX 75039

EXAMINER	
MANOHARAN, MUTHUSWAMY GANAPATHY	
ART UNIT	PAPER NUMBER
2617	

NOTIFICATION DATE	DELIVERY MODE
04/16/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

portfolioprosecution@rim.com

Office Action Summary	Application No.	Applicant(s)	
	10/777,478	FUNNELL, NICOLA	
	Examiner	Art Unit	
	MUTHUSWAMY G. MANOHARAN	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 7-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 7-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/30/2009 have been fully considered but they are not persuasive.

Applicant argues that Tohono does not disclose the identifying, Tohono can not disclose reading and acting upon the system information if the same information elements are related. Applicant has not provided what to perform if the condition “Is same information element relating to cell information list in more than one SIB? fails.

Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the requirements.

Tohono is performing reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the applied defined order in the user equipment device specifies reading and acting upon that system information associated with the information element from SIB 11 and the reading and acting upon the system information associated with the information element from SIB 12. The action “performing in a defined order” satisfies both the conditions (true or false).

Applicant is arguing that Tohono does not disclose a user equipment device that receives, reads, and acts upon system information associated with the identified same information elements according to the defined order.

3GPP in view of Tonhono teaches a user equipment device that receives, reads, and acts upon system information (3GPP teaches receiving SIB 11 and SIB 12 as shown in the prior art rejection; also in Paragraph [0012],"UE acts upon the received IE", Applicant's admitted prior art (3GPP)) associated with the identified same information elements according to the defined order (Tohono teaches performing the action in a defined order. Tohono teaches active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]. Therefore, Tohono teaches a defined order that specifies reading and acting upon system information.

Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the requirements.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, 3GPP is part of UMTS standard and Tohono is providing specific way performing the measurements (an improvement) over the existing 3GPP specifications.

Laitenen reference is not relied upon for the above limitations and therefore, the arguments related to Laitenan are moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference (A)) in view of Tohono (US 2003/0040312).

Regarding **claim 1,** Reference (A) teaches a method for handling system information in a user equipment device configurable for use in a mobile telecommunications system, the method comprising:

receiving a system information block of type 11 (SIB 11)("system Information Block type 12 (SIB 12)" in Section 8.1.1.6.11) relating to idle and connected mode (line 2 ,14, and 22 in Section 8.1.1.6.11) and a system information block of type 12 (SIB 12) ("system Information Block type 12 (SIB 12)" in Section 8.1.1.6.12) relating to connected mode (line 1 in Section 8.1.1.6.12), each of the system information blocks of type 11 (SIB 11) and 12 including at least one system information block information element (lines 29-31 in Section 8.1.1.6.11) the information element related to a cell information list (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section

8.1.1.6.12) and having associated system information ("measurement identity", line 20 in Section 8.1.1.6.11);

identifying if a same information element from each of the SIB 11 and the SIB 12 are related to at least one cell information list (lines 49-50 in Section 8.1.1.6.11 and section 8.1.1.6.12); and

Reference (A) did not teach specifically arranging the user equipment device to apply certain received information elements in a defined order and if the same information elements are related to the at least one cell information list, then reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the applied defined order in the user equipment device specifies reading and acting upon that system information associated with the information element from SIB 11 and the reading and acting upon the system information associated with the information element from SIB 12.

However, Tohono teaches in an analogous art method of arranging the user equipment device to apply certain received information elements in a defined order and if the same information elements are related to the at least one cell information list, then reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the applied defined order in the user equipment device specifies that system information associated with the information element from active set and the reading and acting upon the system information associated with the information element from candidate cell (active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059];

Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona,

Note: the condition if the same information elements are related to at least one cell information list, then reading and acting upon … is ineffective. Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the requirements.

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of arranging the user equipment device to apply certain received information elements in a defined order and If the same information elements are related to the at least one cell information list, then reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the applied defined order in the user equipment device specifies that system information associated with the information element from active set and the reading and acting upon the system information associated with the information element from candidate cell in order to provide an efficient search strategy.

In view of above it is apparent that Reference (A) in view of Tohona teaches specifically arranging the user equipment device to apply certain received information elements in a defined order and reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the order defined in the user equipment device specifies that system

information associated with the information element from SIB 11 and the reading and acting upon the system information associated with the information element from SIB 12.

Regarding **claim 2**, Reference (A) teaches a method according to claim 1, wherein the system information block information element is selected from the following system information block information elements; an information element relating to an intra-frequency cell information list (Section 10.3.7.33), an information element relating to an inter-frequency cell information list (Section 10.3.7.13) and an information element relating to an inter-Radio Access network (RAT) cell information list (Section 10.3.7.23).

Regarding **claim 3**, Reference (A) teaches a method according to claim l wherein the system information block information element is any of the following: “intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding **claim 7,** Reference (A) teaches a method for handling system information in a user equipment device, the device enablable for use in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells:

Receiving at least one each of System information Block (SIB) 11 and SIB 12; each of the SIB 11 and SIB 12 include one or more information elements (IEs) relating to any of "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-frequency cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12; Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Reference (A) did not teach specifically arranging the user equipment device to apply certain received information elements in a defined order and reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the order defined in the user equipment device specifies that system information associated with the information element from SIB 11 and the applying the system information associated with the information element from SIB 12.

However, Tohono teaches in an analogous art method of arranging the user equipment device to apply certain received information elements in a defined order and reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the order defined in the user equipment device specifies that system information associated with the information element from active set and the applying the system information associated with the information element from candidate cell

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona, Note: the determining condition if so then reading and acting upon … is ineffective. Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies requirements).

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of arranging the user equipment device to apply certain received information elements in a defined order and reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the order defined in the user equipment device specifies that system information associated with the information element from active set and the applying the system information associated with the information element from candidate cell in order to provide an efficient search strategy.

In view of above it is apparent that Reference (A) in view of Tohona teaches specifically arranging the user equipment device to apply certain received information elements in a defined order and reading and acting upon the system information associated with the identified same information elements according to the defined order; wherein the order defined in the user equipment device specifies that system information associated with the information element from SIB 11 and the applying the system information associated with the information element from SIB 12.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference (A) in view of in view of Tohono (US 2003/0040312) and Laitinen et al. (hereinafter Laitinen) (US 6765891).

Regarding **claim 8**, the combinations of Reference (A) and Tohono teaches all the particulars of the claim 1, except a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the

microprocessor, where the microprocessor running the software is configured to carry out at least the operations. However, Laitinen teaches in analogous art, a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations (Col. 4, lines 29-40).. Therefore, it would be obvious to one of ordinary skill in the art at the time invention to implement the method using a a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations. This modification provides a method of implementation of Radio Resource Control protocol for the UE-UTRAN radio interface.

Regarding **claim 9**, Reference (A) teaches the system information block information element is any of the following: “intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding **claim 10**, Reference A further teaches two received SIBs comprise one type SIB 11 and one type SIB 12 (sections 8.1.1.6.11 and 8.1.1.6.12).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUTHUSWAMY G. MANOHARAN whose telephone number is (571)272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617